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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,778	03/03/2006	James A. Fleming III	CRD5013PCT0	6722
27779 7590 07/17/2008 PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003				
EXAMINER				
OU, JING RUI				
ART UNIT		PAPER NUMBER		
3773				
MAIL DATE		DELIVERY MODE		
07/17/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/540,778

**Applicant(s)**

FLEMING III, JAMES A.

**Examiner**

JING OU

**Art Unit**

3773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1.4.6 and 7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1.4.6 and 7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### **DETAILED ACTION**

1. This action is responsive to the non-provisional application filed on 06/27/2005.

Claims 1, 4, 6, and 7 are pending. Claims 1, 6, and 7 are independent.

#### ***Claim Objections***

2. Claim 6 and 7 are objected to because of the following informalities: In the second paragraph of Claims 6 and 7, the recitation "internal space" should be replaced by "internal spaces." Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

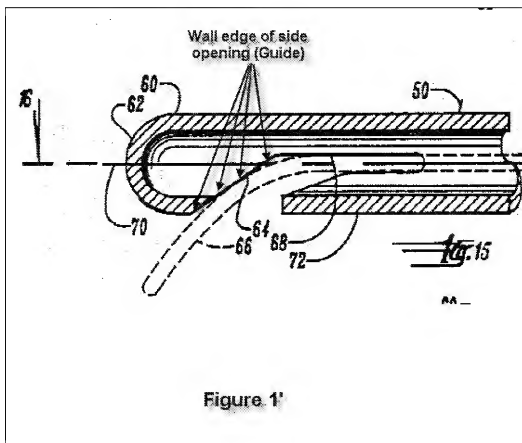
1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1, 4, 6, and 7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Dulebohn (US Pat. No.: 5,171,314).

In regard to Claims 1, 4, 6, and 7, Dulebohn discloses a surgical snare catheter system, comprising: a flexible shaft (tip, 50, Fig. 12, the tip must be flexible since is used inside a body and the tip is small in the diameter, Col. 5, lines 40-42. Applicant should be noted that Applicant did not explicitly define how flexible the shaft should be. The tip 50 must be flexible or capable of bend without breaking.) defining a longitudinal axis having a proximal and a distal end (Figs 1 and 12); the shaft having an opening (side opening, 64, Fig. 12) positioned a distance from the shaft distal end (60, Fig. 12); the longitudinal axis and the shaft follows a curved path (Since the shaft is flexible, it must follows a curved path to get to the target inside the body); the shaft defining an internal space positioned proximally and distally of the opening (the internal spaces of tip 50 proximally and distally of the side opening, Fig. 12); a handle (12, Fig. 1) affixed to the shaft near the shaft proximal end (Fig. 1); an actuator (combination of two slides 36 and 38, Fig. 1) coupled with the handle; a retrieval element (wire, 52, Fig. 12) coupled with the actuator (Col. 6, lines 8-15 and Col. 4, lines, 27-36); the retrieval element being longitudinally movable among a range of positions (Col. 6, lines 8-15 and Col. 4, lines, 27-36), including the position of the shaft opening and the positions of the proximal and distal internal spaces (the wire 52 is capable of moving among the position of the shaft opening and the positions of the proximal and distal internal spaces as shown in Fig. 12); a main wire loop coupled with the actuator (Col. 6, lines 12-15, when the first and second end of the wire are attached, a loop is formed engageably with the control member), wherein a distal portion of the shaft has a pre-selected shape (the pre-selected shape of the distal portion of the shaft is closed hemispherical, 62, Fig. 12),

such that moving the actuator to a desired position causes the retrieval element to move to a corresponding position (Col. 6, lines 8-15 and Col. 4, lines, 27-36); such that when the retrieval element is in an initial position, the retrieval element is located within the internal space (wire 52 must be located within the internal space of the tip 50); such that when the actuator is moved to a ready position, the retrieval element protrudes from the shaft opening (Figs 12 and 13); and a guide (The wall edge of side opening of shaft distal of side opening as shown in the Figure 1' below. The wall edge acts as a guide because it guides to main wire loop to exit the side opening) affixed to the shaft at a guide position distal of the opening, the main wire loop extending at least to said guide position.

The recitations, "the retrieval element can be maneuvered to engage a portion of a filter, and then the actuator can be moved to a first or second capture position which pulls the filter through the opening into a selected one of the first and second internal spaces" in Claims 1 and 6 are intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.



### ***Response to Arguments***

6. Objections to the specification and drawings have been overcome.
7. Applicant's arguments filed 06/16/2008 have been fully considered but they are not persuasive. The allegation on page 9 of the remarks that Dulebohn does not disclose a flexible shaft is incorrect. The tip 50 must be flexible since is used inside a body and the tip is small in the diameter (Col. 5, lines 40-42). In addition, the tip 50 is long and slender, so it inherently has some measure of flexibility. Applicant should be noted that Applicant did not explicitly define how flexible the shaft should be. The tip 50 must be flexible or capable of bending without breaking. The allegation on page 9 of the remarks that the "snare" of Dulebohn cannot be pulled into "a range of positions,

including the position of the opening and the positions of the first and second internal spaces" is incorrect. The "snare" of Dulebohn clearly can be pulled into "a range of positions, including the position of the opening and the positions of the first and second internal spaces" (see Figures 12-16).

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JING OU whose telephone number is (571)270-5036. The examiner can normally be reached on M-F 7:30am - 5:00pm, Alternative Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Uyen (Jackie) T Ho can be reached on (571)272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JO

/Julian W. Woo/  
Primary Examiner, Art Unit 3773